

ESTTA Tracking number: **ESTTA529337**

Filing date: **03/28/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Omer Sabanci Holding A.S.		
Entity	joint stock company	Citizenship	Turkey
Address	Sabanci Center 4 Levent Istanbul, 34330 TURKEY		

Attorney information	Alec P. Rosenberg Arent Fox LLP 1717 K Street, NW Washington, DC 20036 UNITED STATES rosenberg.alec@arentfox.com, henrye@arentfox.com, tmdocket@arentfox.com Phone:202 715 8552		
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### Applicant Information

Application No	85747192	Publication date	03/19/2013
Opposition Filing Date	03/28/2013	Opposition Period Ends	04/18/2013
Applicant	Sedesco, Inc. 444 Madison Avenue New York, NY 10022 UNITED STATES		

### Goods/Services Affected by Opposition

Class 036. All goods and services in the class are opposed, namely: Real estate services, namely, listing, leasing, brokerage, financing and managing commercial, residential and hotel property; Real Estate services, namely, leasing and management for others of residential condominiums located within hotel developments
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## Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

## Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	word mark SABANCI		
Goods/Services	business and educational services, and cross-cultural activities		

Related Proceedings	91205622
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Attachments	Sabanci opp.pdf ( 11 pages )(489883 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Alec P. Rosenberg/
Name	Alec P. Rosenberg
Date	03/28/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application Nos.:

85/747,192, filed on October 5, 2012, and published on March 19, 2013, for the mark  
SABANCI BUILDING; and

85/747,197, filed on October 5, 2012, and published on March 19, 2013, for the mark  
SABANCI PROPERTIES.

**HACI ÖMER SABANCI HOLDING A.Ş.**

**Opposer,**

**v.**

**SEDESCO, INC.**

**Applicant.**

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**Opp. No. \_\_\_\_\_**

**NOTICE OF OPPOSITION**

Opposer Haci Ömer Sabanci Holding A.Ş. (“Opposer”) believes that it will be damaged by the registration of the above identified marks and hereby opposes the same under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. §1063.

As grounds for the opposition, Opposer alleges as follows:

1. Opposer is the parent company of the Sabanci Group, which is Turkey’s leading industrial and financial conglomerate.
2. Since long before the filing date of Applicant’s applications, Opposer has used the name SABANCI in connection with a wide variety of activities and services throughout the world and has, therefore, become intimately associated with the name SABANCI.
3. As a result of the diverse and far-reaching business, educational, and cross-cultural efforts in which Opposer has been engaged for decades, the name SABANCI has

become an exceptionally prominent and renowned business name across the globe, including in the United States (“U.S.”).

4. Opposer conducts extensive business, educational, and cross-cultural activities, and has regular corporate dealings, in the U.S. Through those dealings and activities, a broad range of U.S. consumers are exposed to the trade name SABANCI in a variety of contexts. For example, Opposer has established and maintains partnerships with a variety of prominent U.S. companies and institutions, including Citigroup, Hilton International, E. I. Du Pont de Nemours and Company, International Paper, and Philip Morris, as well as the Massachusetts Institute of Technology (“MIT”) and the Brookings Institution. In addition, Opposer has several affiliates, including KORDSA Global, Dupont-Sabanci International, LLC, BOSSA, and YÜNSA, that have been operating within and marketing to the U.S. for years.

5. Opposer’s majority shareholder is the Sabanci Family, and its Chairman and Chief Executive Officer is Ms. Güler Sabanci, who is an exceptionally well-known business person. Indeed, Ms. Sabanci has been recognized repeatedly as one of the world’s most powerful businesswomen by the U.S. magazines *Forbes* and *Fortune*, as well as other leading periodicals such as *The Financial Times*, each of which, on information and belief, has widespread circulation in the U.S. Ms. Sabanci has also repeatedly appeared on CNN. At a ceremony in New York in September 2011, former U.S. President Bill Clinton’s organization, the *Clinton Global Initiative*, awarded Ms. Sabanci one of its “Clinton Global Citizen Awards,” which honor individuals who have made an outstanding impact in philanthropy, government, civil society, and the corporate sector. In November 2011, Ms. Sabanci was listed in a *Financial Times*’ “Women at the Top” feature that recognized outstanding female leadership and gender diversity in the corporate world. In April 2012, United Nations (“UN”) Secretary-General Ban

Ki-moon appointed Ms. Sabanci to the Global Compact Board, the UN's highest-level advisory body involving business, civil society, labor, and employers' organizations.

6. Applicant is owned by Demir Sabanci, who is Güler Sabanci's cousin. Mr. Sabanci operates Applicant independently of, and has no direct affiliation with, the Sabanci conglomerate.

7. Notwithstanding the enormous notoriety and prestige of the SABANCI name, on October 5, 2012, Applicant filed application Serial Nos. 85/747,192 and 85/747,197, seeking to register, respectively, the marks SABANCI BUILDING and SABANCI PROPERTIES, each for "real estate services, namely, listing, leasing, brokerage, financing and managing commercial, residential and hotel property; real estate services, namely, leasing and management for others of residential condominiums located within hotel developments," in Class 36.

8. Each of Applicant's alleged marks wholly incorporates the name SABANCI as its dominant component. Indeed, the only difference is the inclusion of the descriptive terms "BUILDING" and "PROPERTIES." As such, each of Applicant's alleged marks clearly draws a connection between the services listed in the application and the worldwide notoriety of Opposer.

9. Opposer is not connected with any of the activities to be performed by Applicant under Applicant's alleged marks and has not granted to Applicant any rights associated with the name SABANCI. Indeed, neither Applicant nor any of the services Applicant intends to offer under the alleged marks is affiliated or connected with Opposer.

10. Opposer and the SABANCI name through which Opposer conducts its business, educational, and cross-cultural activities enjoy such notoriety and prestige around the world, including in the U.S., that persons in the U.S., upon seeing the marks SABANCI BUILDING

and SABANCI PROPERTIES, will recognize each mark as pointing uniquely and unmistakably to Opposer. By way of example only, *Fortune* magazine has repeatedly named Opposer among “The Fortune Global 500,” which celebrates the world’s top industrial corporations. In 1994 and 1995, *Fortune* published extended articles celebrating Opposer’s 75-year legacy in the international business community. Likewise, both Güler Sabanci and the prior head of the Sabanci conglomerate, the late Sakip Sabanci, have been recognized repeatedly by *Fortune* magazine for the enormous wealth they and their families have amassed by virtue of Opposer’s widespread and successful enterprises.

11. Indeed, Opposer has been the focus of numerous, widely circulated reports and advertisements in the U.S. For example, in 1995, the *Financial Times* stated that “the Sabanci (pronounced Sabanji) family industrial empire[’s] . . . 47 companies employ 30,000 people in businesses ranging from banking to cars to textiles, with an annual group turnover of \$6 b[illio]n.” In 1996, *TIME* wrote that “[e]bullient but simple pragmatism is the brisk style of Mr. Sakip Sabanci, the head of Haci Omer Sabanci Holding, parent company of Turkey’s leading industrial and commercial conglomerate,” and that Opposer “has diverse interests ranging from banking to the manufacture of Toyota cars, and its annual turnover in 1995 was US\$8.4 billion.” In 1996, *Newsweek* noted that Opposer had “exported \$621 million [in 1995] alone,” and that “Sabanci is still growing.” In 1997, *The Economist* reported that Sakip Sabanci had “built a profitable range of businesses that have a combined turnover of more than \$8 billion and reach into almost every corner of the Turkish economy,” and that “[i]n the process, Mr. Sabanci has become Turkey’s second-richest man and, in a land familiar with five-year plans and state-approved monopolies, its most enthusiastic capitalist.” In 1999, *Bloomberg* stated that “Haci Omer Sabanci Holding operates 60 companies in the banking, auto, textile, cement, chemical,

and food industries and exports to more than 100 countries.” In 2000, *Fortune* noted that Opposer “is a Turkish industrial giant with an impressive record of creating 50-50 partnerships with major foreign players,” and that after “contribut[ing] a staggering 5.7 percent of the country’s tax revenue” in 1999 and “[a]fter years of doing deals with multinationals, Sabanci Holding is becoming one in its own right.” In 2001, *The Wall Street Journal Europe* reported that “Ms. Sabanci has played a key role in building Sabanci Holding’s 17 50-50 joint ventures with major multinationals, including Toyota Motor Corp., Philip Morris Cos., International Business Machines Corp., Dresdner Bank AG and a \$1 billion deal with DuPont Co.”

12. U.S. consumers regularly access information about Opposer and its activities. Indeed, on information and belief, “click-rate” data for Opposer’s website ([www.sabanci.com](http://www.sabanci.com)) indicates that U.S.-based computers were responsible for between 18% and 20% of the traffic on Opposer’s website between 2009 and 2011.

13. Opposer also serves as an important bridge between Turkey and the U.S. in leading academic and intellectual circles. For example, since 1999, Opposer has operated the Sabanci University, which was modeled after U.S. institutions of higher learning and was designed by the award-winning, U.S.-based architecture firm Cannon Design. Graduates of Sabanci University now work or study in the United States.

14. Since its inception, Sabanci University has partnered with some of the most respected and influential U.S. institutions. For instance, Sabanci University operates an ongoing dual-degree program with MIT’s Sloan School of Management and, since 2005, has partnered with the Brookings Institution to present a series of international conferences under the title “Sakip Sabanci Conference Series.” Highly prominent Americans have participated in those conferences, including former U.S. Secretary of State Madeleine Albright, former World Bank

President Paul Wolfowitz, and former Assistant U.S. Secretary of State Richard Holbrooke. In 2009, Sabanci University organized a series of events titled “Darwin and Beyond” to celebrate the Darwin bicentennial, which commenced with a lecture by Professor Daniel Dennett, the Co-director of the Center for Cognitive Studies and the Austin B. Fletcher Professor of Philosophy at Tufts University. The Sabanci University also organized a 2009 lecture by Martin J. Sherwin, the Pulitzer Prize-winning former Walter S. Dickson Professor of English and American History at Tufts University, entitled “A Nuclear World and President Obama’s Abolition Vision, Oppenheimer’s Legacy.” In addition, Sabanci University has partnered with the New York-based Turkish Philanthropic Fund to establish the “Friends of Sabanci University Fund,” which conducts fundraising activities for Sabanci University in the U.S. Sabanci University also participates in the U.S. State Department’s “Global Entrepreneurship Program,” which promotes entrepreneurship as a key pillar of economic development among developing countries under the guiding hand of U.S. Secretary of State Hillary Rodham Clinton.

15. The reputation of the SABANCI name extends to artistic and cultural pursuits as well. For example, since 1998, Opposer has operated the Sakip Sabanci Museum, which has been home to a rich collection of calligraphy and paintings and has hosted numerous comprehensive exhibitions, conservation units, model training programs, concerts, conferences, and seminars. Prominent American business leaders, such as Martha Stewart, have visited the Sakip Sabanci Museum, and Opposer’s world-renowned collection of Ottoman calligraphy has been exhibited in the U.S. in cooperation with the New York Metropolitan Museum of Art and the Los Angeles County Museum of Art.



16. U.S. consumers are thus frequently exposed to the name SABANCI in a wide variety of contexts as a result of Opposer's extensive business, educational, and cross-cultural activities.

17. By virtue of Opposer's prominence and reputation in the relevant circles, Applicant's alleged marks, when used in connection with services of the type described in its applications, will cause the consuming public to mistakenly presume a connection between Applicant and its services, on the one hand, and Opposer, on the other hand.

18. Use and registration of Applicant's alleged marks will deprive Opposer of the ability to protect its reputation, persona, and goodwill.

19. By reason of the foregoing, Opposer will be damaged by the registration of each of Applicant's alleged marks, and registration of each should be refused.

**Count I - False Suggestion of Connection - § 2(a)**

20. Opposer hereby incorporates by reference the allegations contained in paragraphs 1 through 19, above.

21. Each of Applicant's alleged marks thus falsely suggests a connection with Opposer, in violation of Section 2(a) of the Trademark Act, because each implies that such mark, Applicant, and/or the services to be offered under such mark are associated with the Sabanci business conglomerate and its activities, which is not true. In particular, each of Applicant's alleged marks is unregistrable under Section 2(a) because (i) it is identical to, or a close approximation of, the SABANCI name, (ii) it points uniquely and unmistakably to Opposer, (iii) Opposer is not connected with the activities performed by Applicant under its alleged mark, and (iv) Opposer's name SABANCI is of sufficient fame that a significant portion of the U.S.

consumers of Applicant's services would presume a connection between each of Applicant's alleged marks and Opposer.

22. On information and belief, Applicant intends to establish a connection between its alleged mark and Opposer.

**Count II - Likelihood of Confusion - § 2(d)**

23. Opposer hereby incorporates by reference the allegations contained in paragraphs 1 through 22, above.

24. As evidenced by Opposer's extensive business, educational, and cross-cultural activities and regular corporate dealings in the U.S. under the name SABANCI, as well as the extensive media attention those dealings have attracted in the U.S., Opposer's open and public use of that name has resulted in the development of a trade identity that has created, in the mind of the relevant purchasing public, an association between the designation SABANCI and a wide range of commercial endeavors, including endeavors related to Opposer's services.

25. The marks sought to be registered by Applicant so resemble Opposer's SABANCI trade name that the use and registration of Applicant's alleged marks would likely cause confusion, mistake, and deception as to the source or origin of Applicant's services, or cause the public to assume erroneously that Applicant's services are in some way connected with and/or sponsored by or affiliated with Opposer, all within the meaning of Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), as amended, and will injure and irreparably damage Opposer and the goodwill and reputation it has established in its well-known SABANCI trade name.

26. If Applicant is granted registrations of the subject marks, Applicant will obtain the prima facie exclusive right to use the alleged marks in the United States, and such

registrations will impair and diminish Opposer's goodwill and rights in its SABANCI trade name, thereby causing irreparable damage and injury to Opposer.

### **Count III - Fraud**

27. On October 5, 2012, in filing each of the opposed applications, Applicant made the material false statement that "[t]he wording SABANCI has no meaning in a foreign language."

28. At the time Applicant filed each application, Applicant knew that this material statement was false because the term "Sabanci" is, in fact, a Turkish word that carries a strong, unique, and unmistakable meaning and association – namely, as the trade name of the iconic SABANCI conglomerate of companies. Moreover, although the SABANCI name originated as the surname of the family that founded and has always controlled Opposer, that name has since gained a powerful secondary meaning throughout the world by virtue of its use as the corporate name of that conglomerate. Thus, contrary to Applicant's statement that the term "Sabanci" has no meaning in a foreign language, applicant was undeniably aware of the true meaning of the term "Sabanci" at the time Applicant made these material false statements since its owner, Mr. Demir Sabanci, is a member of Sabanci family.

29. Applicant made these false statements with an intent to induce the PTO to approve Applicant's alleged marks for publication. More specifically, had Applicant been truthful in its statements contained in the opposed applications, the PTO would have refused to allow the marks shown in the opposed applications to proceed to publication on the basis of one or more of the prohibitions contained in Section 2 of the Lanham Act.

30. The PTO relied on these false statements made by Applicant in approving the applications for publication.

31. But for the false statements made by Applicant, the PTO would not have approved the applications.

WHEREFORE, Opposer prays that this opposition be sustained and that registration be denied.

**HACI ÖMER SABANCI HOLDING A.Ş.**

Dated: March 28, 2013

By:



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## CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this Notice of Opposition is being served on March 28, 2013, upon Applicant's counsel via first-class mail, postage prepaid, at the following address:

WILLIAM M. BRODSKY  
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